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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
37370-33

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "~~Mail Stop AF~~, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on January 17, 2006

Signature Jennifer D. Gaines

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Application Number	Filed
10/752,641	January 6, 2004

First Named Inventor
Gary Wayne Bagnall

Art Unit	Examiner
3644	Shaw, Elizabeth Anne

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number 41,338

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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January 17, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

Appellant's Pre-Appeal Conference Remarks

Claims 1-3, 5, 6 and 8-28 remain pending in the application, with claims 1, 5, 8, 10, 11 and 15 being the independent claims. Claims 1-3, 5, 6, 8, 9, 15, 21-23 and 26 have been allowed, and claims 14, 24 and 25 have been indicated as reciting allowable subject matter and would be allowed if rewritten into independent form.

However, claims 10-13, 16-20, 27 and 28 stand rejected under 35 USC § 103(a) over U.S. Patent 5,722,347 (Tominaga) in view of U.S. Patent 2,727,489 (Sklar). For the following reasons, Appellant continues to believe that these rejected claims also should be allowed.

The present invention concerns floating-dock apparatuses for use within an aquarium. A dock according to the present invention generally can be used to allow turtles and other aquatic animals to climb out of the water when desired. More specifically, each of the apparatuses of the present invention involves a dock that floats with the water level in an aquarium, along one or more rails.

In the broadest rejected claims, attachment means are provided for attaching a rail, for that purpose, to a top edge of the aquarium (claim 10), or support means are provided for supporting such a rail so that the rail extends into the aquarium from a location outside of the aquarium (claim 11).

The attachment means of claim 10 can include, e.g.: (i) hooks, such as hooks 82 illustrated in Figure 3 of the Specification or (ii) a clamping mechanism, such as described on page 5 lines 6-8 of the Specification. The support means of claim 11 can include, e.g.: (1) hooks, such as hooks 82 illustrated in Figure 3 of the Specification or (2) a support structure that is mounted or positioned outside of the aquarium, such as described on page 2 lines 8-9 or on page 6 lines 16-22 of the Specification.

By virtue of either such arrangement, it often is possible to remove the rail(s) and/or the floating dock from the aquarium, even when the aquarium is filled with water, without getting one's hands wet. Accordingly, such a structure often can facilitate cleaning or maintenance of the dock and/or rail(s). At the same time, such a structure typically can be implemented so as to provide adequate support for the rail(s).

Thus, independent claim 10 is directed to an apparatus for use in an aquarium, in which is provided an attachment means for attaching a provided rail to a top edge of an aquarium so that the rail runs along an inside surface of a wall of the aquarium. A buoyant dock element has sliding means for attaching to the rail and for allowing the dock element to freely slide along the rail as a water level in the aquarium varies.

The foregoing combination of features is not disclosed or suggested by the applied art. For instance, no permissible combination of Tominaga and Sklar would have disclosed or suggested at least the feature of attachment means for attaching a floating-dock-element rail to a top edge of an aquarium so that the rail runs along an inside surface of a wall of the aquarium.

In this regard, Tominaga describes a floating island that moves up and down with the water level along supporting rods that are attached with suction cups to the bottom surface or the side wall of an aquarium. However, as acknowledged by the Examiner, Tominaga does not suggest the use of any attachment means as presently claimed.

In order to make up for this deficiency, the Examiner also cites Sklar, which describes an aquarium fish-feeding station that is hooked to the top edge of an aquarium. More specifically, the Examiner has asserted that it would have been obvious to use Sklar's hooks as an attachment means for Tominaga's device "as a replacement of functional equivalents". This argument is believed to be inappropriate for the following reasons.

MPEP § 2144.06 provides, "In order to rely on equivalence as a rationale supporting an obviousness rejection, the *equivalency* must be recognized in the prior art, and *cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents*." [Emphasis added]. One example given in § 2144.06 is In re Scott, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) (Claims were drawn to a hollow fiberglass shaft for archery and a process for the production thereof where the shaft differed from the prior art in the use of a paper tube as the core of the shaft as compared with the light wood or hardened foam resin core of the prior art. The Board found the claimed invention would have been obvious, reasoning that the prior-art foam core is the functional and mechanical equivalent of the claimed paper core. The court reversed, holding that components which are functionally or mechanically equivalent are not necessarily obvious in view of one another, and in this case, the use of a light wood or hardened foam resin core does not fairly suggest the use of a paper core.)

In the present case, as noted by the Examiner, hooks have a certain generic functional equivalence to suction cups, i.e., in the very broad sense that each can be used for attaching one element to another. However, there is absolutely no evidence of recognition in the applicable art of equivalence between Tominaga's suction cups and Sklar's hooks for the present purpose, i.e., in connection with a rail upon which a floating aquarium dock can slide.

It is noted that neither Tominaga nor Sklar (the only two applied prior-art references) says anything at all about using hooks in connection with any type of guide rail, much less the particular kind of rail recited in the present claims. Tominaga's island support rods are attached to the bottom or to the side wall of an aquarium using suction cups. Sklar simply discloses a feeding station that is attached at a fixed position on an aquarium wall using a pair of hooks.

Absent any prior-art recognition of equivalence between Tominaga's suction cups and Sklar's hooks for the presently recited purpose, MPEP § 2144.06 clearly indicates that there is no basis for asserting that it would have been obvious to make the asserted modification.

In fact, Tominaga itself appears to teach away from any such substitution. Specifically, the top ends of Tominaga's support rods are decorated so that the support

rods resemble palm trees. Replacing his suction cups (or weights) by using hooks at the top ends of his supporting rods would have significantly changed his only described embodiment. Therefore, without any explicit suggestion to do so, such a modification would not have been obvious to one of ordinary skill in the art.

Moreover, the main embodiment described in Tominaga concerns an apparatus in which the supporting rods are attached to the bottom surface of the aquarium using suction cups. Apparently, the only alternate embodiments that are mentioned are: one in which the supporting rods are bent at a right angle and attach with suction cups to the lower side wall of the aquarium and another in which the suction cups are replaced with weights or sinkers, so that the bottoms of Tominaga's support rods are weighted to the bottom of the aquarium.

Thus, Tominaga clearly teaches that the supporting rods in his apparatus should be supported within the aquarium at their *bottom* ends. The asserted replacement of Tominaga's suction cups with Sklar's hooks would be directly contrary to such teachings.

Finally, even if there were some motivation to somehow attempt to combine the teachings of Tominaga and Sklar, there is absolutely nothing to indicate that the combination would have resulted in the present invention, as recited in independent claim 10. As noted above, Sklar only teaches the use of hooks for fixedly attaching a feeding apparatus to the top edges of an aquarium. It says nothing at all about rails. Accordingly, any permissible combination of Tominaga and Sklar more likely would have resulted in hooking a fixed-position platform onto the top edge of the aquarium (in the same manner that Sklar's feeding device is fixedly attached to the aquarium), rather than a rail-guided sliding dock element, as presently recited.

Appellant made the foregoing points in the most recently filed Response to Office Action. However, it appears that the Examiner has only responded to the point stated above to the effect that the asserted combination would require the elimination of Tominaga's palm-tree configuration, which is Tominaga's only described embodiment. In attempting to refute that particular point, the Examiner simply asserts, "if the suction cup 3 used in figure 4 were replaced with the hooks of Sklar, the aesthetic design of the device would be maintained and the support structure of the device would then be replaced by the functional equivalents of suction cups to hooks to maintain the placement of the device in the aquarium."

However, it is unclear how this assertion possibly could be true. Placing hooks on the tops of Tominaga's support rods necessarily would require the removal of the tops of Tominaga's palm trees (thereby eliminating any feature that would identify his support rods as palm trees, as Tominaga intended). Alternatively, if hooks were placed on the bottoms of Tominaga's palm trees, either they would have nothing to which they could attach so as to provide the required support (thereby defeating their functional purpose) or the palm trees would have to be hung upside down from the upper edge of the aquarium (thereby once again destroying the desired aesthetic effect).

In short, the only motivation to combine Tominaga and Sklar in any manner that would have resulted in the present invention could only have come from Appellant's own disclosure. That, however, is of course an impermissible basis for combining two significantly different prior-art references.

In fact, it appears that the only similarity between Tominaga and Sklar is that both can be used in an aquarium. Neither reference (nor any other prior art) suggests the desirability of combining the teachings of these two very different references. Absent any such explicit suggestion, particularly in view of the fact that they describe devices that are so different from each other, there would have been no motivation to combine such references in any manner whatsoever. Moreover, even if there were some motivation to attempt to combine them, the combination still would not have resulted in the present invention. To the contrary, the asserted combination would have resulted in a substantial change to the primary applied-art reference.

As noted above, the present invention provides an improvement over the device disclosed in Tominaga, e.g., typically allowing easier removal of the rail(s) and/or dock element even when the aquarium is full of water. Prior to the present invention, there simply would have been no motivation to modify Tominaga's device and by adding to it attachment means for attaching a floating-dock-element rail to a top edge of the aquarium so that the rail runs along an inside surface of a wall of the aquarium, as presently recited.

As further noted above, most of the points set forth above have not been addressed at all. Based on the foregoing discussion, independent claim 10 is believed to be allowable over the applied art.

Independent claim 11 is directed to an apparatus for use in an aquarium. The apparatus includes a rail and support means for supporting the rail so that the rail extends into the aquarium from a location outside of the aquarium. A buoyant dock element has sliding means for attaching to the rail and for allowing the dock element to freely slide along the rail as a water level in the aquarium varies.

The foregoing combination of features is not disclosed or suggested by the applied art. For instance, no permissible combination of Tominaga and Sklar would have disclosed or suggested at least the feature of support means for supporting a floating-dock rail so that the rail extends into the aquarium from a location outside of the aquarium.

In the current Office Action, independent claim 11 is rejected on precisely the same grounds as independent claim 10. The points raised above in connection with independent claim 10 primarily refute the arguments raised by the Examiner regarding the alleged obviousness of modifying Tominaga's device to include hooks in the manner of the present invention.

Accordingly, for similar reasons to those set forth above, independent claim 11 is believed to be allowable over the applied art. The other rejected claims depend from independent claims 10 and 11 and are therefore believed to be allowable for at least the same reasons.